IN THE

Supreme Court of the United States

OCTOBER TERM, 1960.

No. 232

POPEIL BROTHERS, INC.,

Petitioner,

vs.

KARL ZYSSET AND NEW NEL KITCHEN PRODUCTS COMPANY,

Respondents.

PETITIONER'S REPLY TO RESPONDENT'S BRIEF IN OPPOSITION.

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Respondents' attempted flight from the question presented by the Petition demonstrates that the Writ should be issued and the case remanded for a further hearing.

Respondents would have met the question, would have cited at least one case authorizing or endorsing the novel procedure here indulged in by the Court of Appeals, had they been able so to do.

Petitioner does not ask this Court to consider the validity of any patent claim. Petitioner seeks only a fair hearing and a complete record upon an issue of law and fact which first came into existence as a result of the decision by the Court of Appeals.

Certainly Courts of Appeals should not act as *nisi prius* courts (or as the Patent Office), as was done here. This

is true generally, and is particularly true in patent cases in which reviewing courts need all the assistance they can get from the Patent Office and from findings by the District Court directed to any new theory that a Court of Appeals thinks may apply. But the Court of Appeals in substance granted a "new" patent which the Patent Office did not grant, and upon the basis of a claim which the District Court did not find could stand independently.

This error was not "induced" by Petitioner as the bitter Brief in Opposition charges. Petitioner never suggested that either Claim 1 or Claim 2 of the Zysset patent was valid, nor did it "induce" the Court of Appeals to so hold. When that Court rendered its opinion that base Claim 1 was anticipated by prior art but that dependent Claim 2 embodied invention, it nevertheless (initially) affirmed the District Court *in toto*, *i. e.*, held *both* claims valid (Petition, p. 23). By Petition for Rehearing, it was pointed out that the only order the Court of Appeals could enter *consistent with its opinion* was to reverse the District Court as to Claim 1 and affirm it as to Claim 2. The Court did this (Petition, p. 24).

To point out, as Petitioner did, the only form of order the Court could enter *consistent with its opinion* was not to urge or to admit that the opinion or its result was correct.

The baseless charge that Petitioner induced the Court of Appeals to come to its erroneous conclusion is accomplished through the old device of a fractured quotation. Rather than approving what the Court had done, it was said in the Petition for Rehearing:

> "The foregoing conclusion [that a sinuous blade constituted invention] of the Court (*with which we disagree* but which we recognize) justifies a finding that Claim 2 of the Zysset patent was valid but it cannot possibly save Claim 1." (Italics supplied.)

And the asserted prayer of the Petition, only partially quoted at page 7 of the Brief in Opposition, again pointed out that the Court's order had to be changed to maintain

> "• • • *consistency with the basic reasoning of the opinion as it now stands*, so as to order that the District Court be affirmed in holding that Zysset's Claim 2 was valid, and be reversed in holding that Zysset's Claim 1 was valid."

(The words italicized above are omitted from the quotation in the Brief in Opposition. What Petitioner prayed was merely that the order be made consistent with the opinion—quite different from a prayer that the patent be held valid.)

Throughout these proceedings Petitioner has vigorously asserted that the entire Zysset patent (Claims 1 and 2) was invalid.

It is said that the contention now made should have been presented at the trial. Petitioner might equally well say that Respondents should have contended at the trial that dependent Claim 2 should stand alone even if its base Claim 1 was invalid. The issue as to validity of dependent Claim 2 independently of its base Claim 1 came into existence solely by the unprecedented action of the Court of Appeals. Up to that point both parties had proceeded, as is customary, upon the assumption that the issue was the validity of the base claim and that the dependent claim stood or fell with it.

The record will be searched in vain for a single finding by the District Court as to the validity of dependent Claim 2 considered independently from its base Claim 1. All of the District Court's findings combined Claims 1 and 2, and were made on the premise that base Claim 1 was valid (Appendix to Brief of Defendant-Appellant, p. 477; *et seq.*).

The citations by Respondents in their Brief in Opposition of decisions by this and other courts that separate claims of a patent are "independent inventions" (*Leeds & Catlin* v. *Victor Talking Machine Co.* at p. 9, *Wire Tie Machine Co.* v. *Pacific Box Corporation* at p. 11, and others) are inapt and wholly immaterial to the question presented by the Petition. All of these cited cases involved separate *complete* claims of a patent, *not dependent claims*. Respondents have not cited a single prior case of this Court or of a Court of Appeals, and Petitioner can find none, in which a *dependent* patent claim was held to be a separate invention independently of its base claim. The decision of the Court of Appeals here is wholly without precedent.[1]

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1. Petitioner has cited important case law in support of its uncontroverted position that dependent Claim 2 has never been independently examined for patentability by the United States Patent Office. The case law cited by Petitioner (Petition, p. 6, footnote 2) clearly confirms the Patent Office practice of automatically allowing a dependent claim *without independent examination* so long as its base claim has been separately scrutinized and evaluated and found to be patentable. Respondents merely state (at p. 19 of their Brief in Opposition) that they "do not believe," this. This naked "belief", however, is not supported by the citation of a single case to the contrary by Respondents. Unlike Respondents' evasive summaries of unrelated aspects of the cases relied upon by Petitioner to confirm this practice of the Patent Office, the cited decisions themselves are unequivocal and emphatic as shown by the following.

By the Court of Customs and Patent Appeals:

> "Appellant argued in his brief that certain dependent claims should be considered allowable if their antecedent claims were allowed. *Certainly that is sound law but if the antecedent claims are not patentable, clearly the limitations in dependent claims are insufficient.*" (Emphasis added.) *Application of McCarn*, 212 F. 2d 797.

By the Patent Office Board of Appeals:

> "Only six claims are now present in the application and since the rejected [dependent] claims differ in scope from the allowed [base] claims, *we do not believe it necessary for appellant to show a patentable difference.*" (Emphasis added.) *Ex Parte Hofstadter*, 96 USPQ 449.

Respondents' Brief in Opposition appears to be nothing else but a charge that the Petition departs from the record and attempts to mislead the Court by inaccurate illustrative figures on page 5 of the Petition. This reckless charge is false:

The illustrations on page 5 of the Petition are completely accurate cross-section reproductions of the material parts (convoluted blades) of the Suter and Zysset patents.

The illustration at the bottom of page 5 of the Petition was taken from Fig. 5 of the Suter patent as shown in the printed record. The angles of convolution in Fig. 5 of the patent (Appendix to Brief of Defendant-Appellant, p. 537) are precisely duplicated on page 5 of the Petition. The only difference is that the patent drawing shows a cross-section of the carrying structure as well as the blade, whereas page 5 of the Petition shows only a cross-section of the blade at a level closer to its cutting edge and thereby presents a narrower appearance. It is the convolution of the blade and its cutting edge, not the width of the carrying structure, that is in issue here.

The illustration at the top of page 5 of the Petition was taken directly from Fig. 2 of the Zysset patent at page 544 of the printed Appendix to Brief of Defendant-Appellant, eliminating, however, everything from the patent drawing save a cross-section of the blade itself. Again the number of convolutions and their angles are precisely reproduced.

We cannot understand how Respondents felt free to charge that the illustrations were inaccurate.

Respondents assert (at p. 2 of their Brief in Opposition) that the Petition "disregards the record and without telling this court that it is doing so," and refer to the Petition's reference to a matter of common knowledge and to the Wilson and McCallay patent. It is a matter of com-

mon knowledge that men have been making knives in sundry convoluted shapes for hundreds of years. The truth of that obvious observation (fatal to the Court of Appeals' holding that a "sinuous" blade is novel) is not contested by our opponents. When counsel refers to a matter of common knowledge, he obviously is not misleading a court into thinking that he is referring to a formal record. And so far as the Petition's reference to the Wilson and McCallay patent is concerned, the Petition specifically told the Court (Petition, p. 7) that this patent was *not* in the record and that the reason it was not in was because the issue had never been tried out.

CONCLUSION.

If the Brief in Opposition is stripped to its legal essentials, it will be seen that it fails to cite a single case in which the procedure adopted by the Court of Appeals has ever been followed or has ever been held proper. If there was such a case it would have been cited at length.

We submit that the procedure followed here by the Court of Appeals was grossly improper. We think the Court of Appeals should have struck down dependent Claim 2 with its base Claim 1. But the least it could have done was to send the case back to the District Court for appropriate findings as to whether Claim 2 could stand alone as an independent patent monopoly. It acted without the benefit, pro or con, of such findings.

If certiorari is granted and the case remanded for further proceedings as we pray, proper judicial procedure will have been enforced. No legal harm will come to Respondents, for *if* (contrary to our belief) Claim 2 in fact can stand alone, the District Court, after proper evidence and findings, will so hold. On the other hand, if certiorari not be granted, a precedent permitting Courts of Ap-

peals to depart from their appellate role will stand and a patent monopoly that was not independently examined in the Patent Office or in the District Court will have been created.

Respectfully submitted,

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